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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/544,281

08/03/2005

Laura Quaranta

70220

9446

26748

7590

02/18/2009

SYNGENTA CROP PROTECTION, INC.  
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EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/544,281	<b>Applicant(s)</b> QUARANTA ET AL.	
	<b>Examiner</b> Sabiha Qazi	<b>Art Unit</b> 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-10,13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-10,13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**Non-Final Office Action**

Claim 1-4, 7-10, 13, 15-20 are pending. Amendments are entered. No claim is allowed.

***Summary of this Office Action dated 2/12/09***

1. Continued Examination Under 37CFR 1.114
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. Double Patenting Rejections
6. Response to Remarks
7. Communication

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Applicants' arguments, filed 11/18/2008, have been fully considered.

Rejections not reiterated from previous office actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/2009 has been entered.

**Information Disclosure Statement**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### **Copending Applications**

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

### **Specification**

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### **Double Patenting Rejections**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is

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not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-4, 7-10, 13, 15-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No.10/539,274. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims are generically taught and are obvious over the claimed subject matter of this application. See for example A-B in the prior art represents CH<sub>2</sub>-CH<sub>2</sub>, n=0, and in present claims n=0, p=0. The substituents R<sub>2</sub>, R<sub>4</sub> and R<sub>6</sub> overlap and therefore are generically claimed. The difference is that in the present claims the substituents

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are attached via a carbon wherein the prior art teaches direct link with six membered ring containing a oxygen atom.

The prior art of record is drawn to structurally similar compounds, which differ, from the compounds embraced by the instant claims in that they are homologues. The skilled artisan would have been motivated to modify the teaching of the prior art to prepare homologues because it is recognized in the art that homologues are structurally similar and would be expected to possess similar properties. *Ex parte Henze* (POBA 1948) 83 USPQ 167.

Compounds that differ only by the presence of an extra methyl group are homologues. Homologues are of such close structural similarity that the disclosure of a compound renders prima facie obvious its homologue.

The homologue is expected to be prepared by the same method and to have the same properties i.e. useful as pesticides. This expectation is then deemed the motivation for preparing homologues. See *In re Wood* 199 USPQ 137; *In re Hoke* 195 USPQ 148; *In re Lohr* 137 USPQ 548; *In re Magerlein* 202 USPQ 473; *In re Wiechert* 152 USPQ 249; *Ex parte Henkel* 130 USPQ 474; *In re Fauque* 121 USPQ 425; *In re Druey* 138 USPQ 39.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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2. Claims 1-4, 7-10, 13, 15-20 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9-10 of copending Application No.10/543,643, claims 1-4 and 7-8 of 10/543,637, claims 1-4, 7-9 of 10/560,390, claims 1-4, 7-8 of 10/568,715 and claims 1, 7, 8, 12, 13, 15-22 of 10/599,671. In each case claims are considered obvious when  $n=0$  i.e. there is only one hetero ring attached to atom at the left side of the molecule.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims are generically taught and are obvious over the claimed subject matter of this application. See for example A-B in the prior art represents  $\text{CH}_2\text{-CH}_2$ ,  $n=0$ , and in present claims  $n=0$ ,  $p=0$ . The substituents  $\text{R}_2$ ,  $\text{R}_4$  and  $\text{R}_6$  overlap and therefore are generically claimed. The difference is that in the present claims the substituents are attached via a carbon wherein the prior art teaches direct link with six member ring containing a oxygen atom.

The prior art of record is drawn to structurally similar compounds, which differ, from the compounds embraced by the instant claims in that they are homologues. The skilled artisan would have been motivated to modify the teaching of the prior art to prepare homologues because it is recognized in the art that homologues are structurally similar and would be expected to possess similar

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Compounds that differ only by the presence of an extra methyl group are homologues. Homologues are of such close structural similarity that the disclosure of a compound renders prima facie obvious its homologue.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### **Response to Remarks**

Double Patenting rejections are maintained because no terminal disclaimer has been filed.

### **Communication**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571)

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272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/

Primary Examiner, Art Unit 1612

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